REMARKS

Claims 1-10 have been examined on their merits.

The Patent Office objects to claims 2-6 as being dependent upon a rejected base claim. Applicant thanks the Examiner for indicating that claims 2-6 would be allowed if rewritten in independent form. However, instead of rewriting claims 2-6 in independent form, Applicant respectfully traverses the prior art rejections for the reasons set forth below.

Claims 1-10 are all the claims presently pending in the application.

1. Claims 7-10 stand rejected under 35 U.S.C. § 112 (1st para.) as allegedly failing to comply with the enablement requirement. Applicant traverses the rejection of claims 7-10 for at least the reasons discussed below.

Applicant has amended claims 8 and 10 to recite that the weighted-mean-value processor comprises means for averaging the power of the sum signal. In addition, Applicant has amended claims 7 and 9 to recite that the weighted-mean-value processor comprises averaging the power of the weighted and added correlation signals. Applicant submits that the § 112 (1st para.) rejection of claim 7-10 has been overcome, and respectfully requests that the § 112 (1st para.) rejection be withdrawn.

2. Claim 1 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sawahashi *et al.* (U.S. Patent No. 6,069,912) in view of Ono (U.S. Patent No. 6,272,167). Applicant traverses the rejection of claim 1 for at least the reasons discussed below.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

b) The proposed modification of the prior art must have had a reasonable expectation of success, as determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).

c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless of whether the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide

particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not "evidence." *Id.; see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

The combination of Sawahashi *et al.* and Ono fails to teach or suggest a weighted-mean-value processor that weights and adds the correlation signals output from correlation processors, and then averages the weighted and added correlation signals, as recited in claim 1. At best, the combination of Sawahashi *et al.* and Ono discloses a path search circuit that comprises a weighted-mean-value processor that weights and adds correlation signals output from a plurality correlation processors, and then level adjusts the weighted and added correlation signals. There is no teaching or suggestion of averaging weighted and added correlation signals in either Sawahashi *et al.* or Ono. For example, the Patent Office asserts that Sawahashi *et al.* discloses averaging weighted and added correlation signals through the use of a level adjuster circuit (508). *See, e.g.*, Figure 5, col. 9, line 15 of Sawahashi *et al.* There is no disclosure in Sawahashi *et al.* that the level adjuster circuit does anything more that adjust the level of the input signal into the phase fluctuation compensator (510). While the input signal to the level adjuster circuit is from an adder circuit (507) that receives inputs from a plurality of mixer and matched filters,

Sawahashi *et al.* is silent with respect to any averaging function carried out by the level adjuster circuit. Ono is similarly unavailing with respect to the averaging of weighted and added correlation signals. For example, correlation signals are input into a plurality of weighting circuits (130), and the outputs of the weighting circuits are input into a RAKE combiner unit (400). *See, e.g.*, Figure 1 of Ono. There is no disclosure that the weighted correlation signals are summed together and averaged in any manner. Thus, Applicants submit that the Patent Office cannot fulfill the "all limitations" prong of a *prima facie* case of obviousness, as required by *In re Vaeck.*

Since neither Sawahashi *et al.* nor Ono disclose a weighted-mean-value processor that weights and adds the correlation signals output from correlation processors, Applicants submit that one of skill in the art would not be motivated to combine the two references. *In re Dembiczak* and *In re Zurko* require the Patent Office to provide particularized facts on the record as to why one of skill would be motivated to combine the two references. Without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). Although the Patent Office provides a motivation analysis with respect to Ono's alleged disclosure of reception level and timing for a detected peak, both Sawahashi *et al.* and Ono lack any teaching about the desirability of a weighted-mean-value processor that weights and adds the correlation signals output from correlation processors. Since neither reference discloses averaging weighted and added correlation signals, a motivation to combine is lacking. Thus, Applicants submit that the Patent Office cannot fulfill

the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicants submit that the combination of Sawahashi *et al.* and Ono fails to disclose all of the claimed elements as arranged in claim 1. Therefore, the combination of Sawahashi *et al.* and Ono clearly cannot render the present invention obvious as recited in claim 1. Thus, Applicants submit that claim is allowable, and respectfully request that the Patent Office withdraw the § 103(a) rejection of claim 1 and 3.

3. Claims 7 and 9 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sawahashi *et al.* in view of Ono and in further view of Dobbins *et al.* (U.S. Patent No. 5,730,272). Applicant traverses the rejection of claims 7 and 9 for at least the reasons discussed below.

Claims 7 and 9 depend from independent claim 1, and therefore incorporate all of the features thereof. Applicant submits that Dobbins *et al.* fail to cure the deficiencies of Sawahashi *et al.* as discussed above regarding claim 1. Thus, Applicant submits that claims 7 and 9 are allowable at least by virtue of their dependency from independent claim 1, and respectfully requests that the § 103(a) rejection be withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

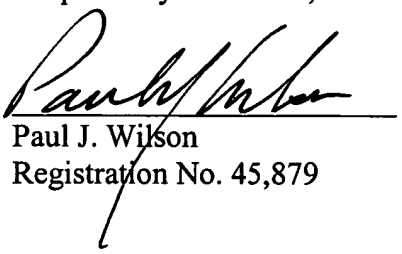

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Fig. 1